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### REMARKS

The foregoing amendments and the following remarks are responsive to the August 11, 2004 Office Action. Claims 2-7, 9-11, and 13-23 remain as originally filed, Claims 1, 8, and 12 are amended, and new Claims 24-27 are added. Thus, Claims 1-27 are presented for further consideration. Please enter the amendments and reconsider the claims in view of the following remarks.

#### **Response to Objection to Claim 8**

In the August 11, 2004 Office Action, the Examiner objects to Claim 8 because of an apparent informality of referring to "the pre-recorded conditional access video content" when no corresponding element is disclosed in parent Claim 1. Applicant has amended Claim 8 to correct this apparent informality. Applicant respectfully requests that the Examiner withdraw the objection to Claim 8 and pass Claim 8 to allowance.

#### **Response to Rejection of Claims 1-4, 6, 9, 12-14, 17, 19, and 23 Under 35 U.S.C. § 102(b)**

In the August 11, 2004 Office Action, the Examiner rejects Claims 1-4, 6, 9, 12-14, 17, 19, and 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,789,785 issued to Hendricks et al. ("Hendricks").

#### Claim 1

As described herein, Applicant has amended Claim 1 to recite (emphasis added):

1. A video system, comprising:
  - an input port configured to receive video data, the video data including a plurality of premium contents;
  - an output port configured to couple to a video display for displaying video data selected by a viewer;
  - a preference engine coupled to the input port and configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of the viewer;
  - a local storage device; and**
  - a promotion module coupled to the preference engine and the output port, **the promotion module responsive to the viewer profile to select at least one preferred promotion content from the plurality of premium contents, to cause the selected at least one preferred promotion content to be stored on the local storage device, and to cause the selected at least one preferred promotion content to be retrieved from the local storage device and displayed to entice the viewer to watch a premium content associated with the selected at least one preferred promotion content.**

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As described by the present application at page 5, line 22 – page 6, line 12 (emphasis added):

The promotion module 16 is coupled to the preference engine 18 and the image generator 14. By using the viewing preferences created by the preference engine 18 for a specific viewer, the promotion module 16 selects from the plurality of premium contents promotion contents that correspond to the preferred contents of this viewer. **The preferred promotion contents may be stored, i.e., pre-recorded within the promotion module 16 or on the storage device 12. ...**

The promotion module 16 may generate a video clip or a trailer as the promotion content 8 for a preferred premium content. In another embodiment, the broadcast head end 7 may broadcast a video clip or a trailer together with a respective premium content so that promotional material is assigned to each premium content. **The storage device 12 or the personal video recorder 20 may then pre-record a plurality of premium contents with assigned promotional materials.** Alternatively, the broadcast head end 7 may broadcast a video clip or a trailer before the respective premium content is sent. For instance, **the video clip may be sent a few days before the scheduled broadcast day of the premium content and recorded on the storage device 12.** On the scheduled broadcast day, for example, prior to the scheduled time, **the control device 10 may then cause the display of the pre-recorded video clip** to entice the present viewer to select the premium content. Likewise, **in case the premium contents are already pre-recorded, the control device 10 may display at least one of the corresponding promotion contents 8 randomly during the present viewer's viewing session** to entice the present viewer to watch one of the pre-recorded premium contents.

In this way, the present application describes various embodiments which include a “promotion module responsive to the viewer profile to select at least one preferred promotion content ..., to cause the selected at least one preferred promotion content to be stored on the local storage device, and to cause the selected at least one preferred promotion content to be retrieved from the local storage device and displayed” as recited by amended Claim 1.

In contrast, Hendricks does not disclose a promotion module as recited by amended Claim 1. The system disclosed by Hendricks does not store selected promotion content on a local storage device or retrieve the stored selected promotion content from the local storage device for display. For example, as disclosed by Hendricks at column 19, lines 19-27 (emphasis added):

Since **a great number of short video clips may be sent continuously**, full or partial screen promotionals (or informationals) may be provided to the subscriber. With this large quantity of promotional video, the subscriber is given the opportunity to “graze” through new movie or television programming selections.

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The subscriber simply grazes from promotional video to promotional video until the desired television program is discovered.

Thus, Hendricks discloses a system which continually displays all the available promotional videos to the viewer. The system disclosed by Hendricks does not select particular videos for storage on a local storage device based on the viewer profile. Therefore, Hendricks does not disclose the system recited by amended Claim 1.

As a further example, at column 30, lines 4-50, Hendricks discloses searching through program abstracts which contain text descriptive of the particular program's content. Hendricks discloses performing the search based on key words and selecting one or more programs to suggest to the viewer based on the results of the abstract search. While Hendricks discloses that the program abstracts can be stored, Hendricks does not disclose responding to a viewer profile by storing selecting program abstracts on a local storage device in response to a viewer profile and by retrieving and displaying stored selected program abstracts from the local storage device.

Applicant submits that amended Claim 1 is patentably distinguished over Hendricks. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 1 and pass amended Claim 1 to allowance.

Claims 2-4, 6, and 9

Each of Claims 2, 3, 6, and 9 depend from amended Claim 1, and Claim 4 depends from Claim 3. Therefore, each of Claims 2-4, 6, and 9 includes all the limitations of amended Claim 1, as well as other limitations of particular utility. Applicant submits that each of Claims 2-4, 6, and 9 is patentably distinguished over Hendricks. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 2-4, 6, and 9 and to pass these claims to allowance.

Claim 12

As described herein, Applicant has amended Claim 12 to recite (emphasis added):

12. A method of operating a video system that receives video data that includes a plurality of premium contents, the method comprising:  
creating a viewer profile representing viewing preferences of a viewer;  
identifying at least one of the premium contents consistent with the viewer profile;  
selecting a promotion content associated with the identified at least one of the premium contents;  
**storing the selected promotion content on a local storage device; and**  
**retrieving the selected promotion content from the local storage device**  
and displaying the selected promotion content to entice the viewer to watch the associated at least one of the premium contents.

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For the reasons discussed above in relation to amended Claim 1, Applicant submits that amended Claim 12 is patentably distinguished over Hendricks. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 12 and pass amended Claim 12 to allowance.

Claims 13, 14, 17, 18, and 23

Each of Claims 13, 14, 17, and 23 depend from amended Claim 12, and Claim 18 depends from Claim 17. Therefore, each of Claims 13, 14, 17, 18, and 23 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. Applicant submits that Claims 13, 14, 17, 18, and 23 are patentably distinguished over Hendricks. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 13, 14, 17, 18, and 23 and pass these claims to allowance.

**Response to Rejection of Claims 5 and 19 Under 35 U.S.C. § 103(a)**

In the August 11, 2004 Office Action, the Examiner rejects Claims 5 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of U.S. Patent No. 5,530,754 issued to Garfinkle ("Garfinkle"). Applicant submits that the limitations of amended Claims 1 and 12 that are missing from Hendricks, as discussed above, are not disclosed by Garfinkle. In addition, Applicant submits that there is no suggestion in the prior art to combine the teachings of Hendricks and Garfinkle. Therefore, Applicant submits that amended Claims 1 and 12 are patentably distinguished over the combination of Hendricks and Garfinkle.

Claim 5 depends from amended Claim 1, and Claim 19 depends from Claim 17 which depends from amended Claim 12. Therefore, Claim 5 includes all the limitations of amended Claim 1, as well as other limitations of particular utility, and Claim 19 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. Applicant submits that Claims 5 and 19 are patentably distinguished over Hendricks in view of Garfinkle. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 5 and 19 and pass these claims to allowance.

**Response to Rejection of Claims 7, 8, and 20-22 Under 35 U.S.C. § 103(a)**

In the August 11, 2004 Office Action, the Examiner rejects Claims 7, 8, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of U.S. Patent No. 5,796,828 issued to Tsukamoto et al. ("Tsukamoto"). Applicant submits that the limitations of amended Claims 1 and 12 that are missing from Hendricks, as discussed above, are not disclosed by

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Tsukamoto. In addition, Applicant submits that there is no suggestion in the prior art to combine the teachings of Hendricks and Tsukamoto. Therefore, Applicant submits that amended Claims 1 and 12 are patentably distinguished over the combination of Hendricks and Tsukamoto.

Each of Claims 7 and 8 depends from amended Claim 1. Claim 20 depends from Claim 19, which depends from Claim 17 which depends from amended Claim 12. Claim 21 depends from Claim 20, and Claim 22 depends from Claim 21. Therefore, each of Claims 7 and 8 includes all the limitations of amended Claim 1, as well as other limitations of particular utility, and each of Claims 20-22 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. Applicant submits that Claims 7, 8, and 20-22 are patentably distinguished over Hendricks in view of Tsukamoto. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 7, 8, and 20-22 and pass these claims to allowance.

**Response to Rejection of Claims 10 and 15 Under 35 U.S.C. § 103(a)**

In the August 11, 2004 Office Action, the Examiner rejects Claims 10 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of U.S. Patent No. 5,977,964 issued to Williams et al. ("Williams"). Applicant submits that the limitations of amended Claims 1 and 12 that are missing from Hendricks, as discussed above, are not disclosed by Williams. In addition, Applicant submits that there is no suggestion in the prior art to combine the teachings of Hendricks and Williams. Therefore, Applicant submits that amended Claims 1 and 12 are patentably distinguished over the combination of Hendricks and Williams.

Claim 10 depends from amended Claim 1, and Claim 15 depends from amended Claim 12. Therefore, Claim 10 includes all the limitations of amended Claim 1, as well as other limitations of particular utility, and Claim 15 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. Applicant submits that Claims 10 and 15 are patentably distinguished over Hendricks in view of Williams. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 10 and 15 and pass these claims to allowance.

**Response to Rejection of Claims 11 and 16 Under 35 U.S.C. § 103(a)**

In the August 11, 2004 Office Action, the Examiner rejects Claims 11 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Williams and further in view of U.S. Patent No. 6,684,194 issued to Eldering et al. ("Eldering"). Applicant submits that the limitations of amended Claims 1 and 12 that are missing from the combination of Hendricks and

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Williams, as discussed above, are not disclosed by Eldering. In addition, Applicant submits that there is no suggestion in the prior art to combine the teachings of Hendricks, Williams, and Eldering. Therefore, Applicant submits that amended Claims 1 and 12 are patentably distinguished over the combination of Hendricks, Williams, and Eldering.

Claim 11 depends from amended Claim 1. Claim 16 depends from Claim 15 which depends from amended Claim 12. Therefore, Claim 11 includes all the limitations of amended Claim 1, as well as other limitations of particular utility, and Claim 16 includes all the limitations of amended Claim 12, as well as other limitations of particular utility. Applicant submits that Claims 11 and 16 are patentably distinguished over Hendricks in view of Williams and further in view of Eldering. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 11 and 16 and pass these claims to allowance.

#### **Comments on New Claims 24-27**

As described herein, Applicant has added new Claims 24-27. Claim 24 depends from Claim 1 and recites that the local storage device comprises a personal video recorder. Claim 25 depends from Claim 1 and recites that the local storage device comprises a hard disk drive within the promotion module. Claim 26 depends from Claim 12 and recites that the local storage device comprises a personal video recorder. Claim 27 depends from Claim 12 and recites that the local storage device comprises a hard disk drive. Support for these new claims is provided by the originally-filed specification, including, but not limited to: Figures 1 and 2; page 4, lines 12-14; page 5, lines 9-10 and 25-27; page 6, lines 2-4; and page 10, lines 14-18. Applicant submits that these new claims do not add new matter to the present application. Applicant respectfully requests that the Examiner consider the patentability of new Claims 24-27 and pass these claims to allowance.

#### **Summary**

For the reasons stated above, Applicant submits that Claims 1-27 are in condition for allowance, and Applicant respectfully requests such action.

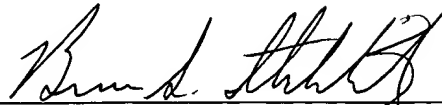
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Respectfully submitted,

Dated: 12/16/04

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